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**REMARKS**

Claims 1-12 and 15-34 are currently pending in the subject application and are presently under consideration. Claim 3 has been amended to more clearly recite the manner in which a first dimension is considered more important than another dimension. Claim 9 has been amended to more clearly define the term "*in situ*" in accordance with the specification. Claims 22-32 have been amended to be more consistent with the original form. Claims 1, 23, 33, and 34 have been amended to incorporate the allowable limitations of original claim 14. Accordingly, no new matter has been introduced, no new search is required, and it is respectfully submitted that the amendments should be entered. Favorable reconsideration of the subject patent application is respectfully requested in view of the amendments and comments herein.

**I. Claim Objection**

Claim 3 is objected to because it is not clear as to how a (first) dimension is considered more important than another (second) dimension.

Claim 3 has been amended to clarify how a first dimension is considered more important than a second dimension according to the specifications. The specification indicates at page 9, lines 2-4, that "the control system 410 can utilize measurements [of overlay error] and design rule requirements relating to the wafer 402 to determine a dimension in which correction is most important." Therefore, the system uses the measurements in the context of design rule requirements (*i.e.*, design level specifications for acceptable overlay error tolerances) to determine which dimension is "more important" than another dimension. Accordingly, claim 3 now recites the limitation that a first dimension is more important (*i.e.*, requires more correction) when design rule requirements tolerate less overlay error in the first dimension when compared to the second dimension as a limitation.

**II. Rejection of Claims 9, 24-25, 27-28 Under 35 U.S.C. §112, second paragraph**

Claims 9, 24-25, and 27-28 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention.

The Examiner states claim 9 is rejected because "*in situ*" for this particular invention is not clearly defined in this claim. Although the claims are interpreted in light of the specification,

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limitations from the specification are not read into the claims. Claim 9 has been amended to more clearly define the term "*in situ*" in accordance with the specifications. As disclosed in the specification at page 18, lines 25-27, the term "*in situ*" refers to a system integrated with at least one process step, as opposed to a stand-alone metrology system. Claim 9 now recites the limitation that the measurement component and the control component are integrated with at least one process step.

The Examiner states claims 24-25 and 27-28 are rejected because "the method of claim 21" and "the method of claim 25" lack antecedent basis. Claim numbers in dependent claims have been changed to correct dependencies.

### **III. Rejection of Claims 1-7, 9-11, 20-23, 25-33 Under 35 U.S.C. §102(b)**

Claims 1-7, 9-11, 20-23, 25-33 are rejected under 35 U.S.C. §102(b) as being anticipated by Chen *et al.* (U.S. 6,218,200). Claims 1-7, 9-11, 19-20, 22-30, 32-33 stand rejected under 35 U.S.C. §102(b) as being anticipated by Knutrud (U.S. 6,662,159).

A rejection based on 35 U.S.C. §102(b) can be overcome by amending the claims to patentably distinguish over the prior art. *See* MPEP 706.02(b). It is noted with appreciation that the Examiner has indicated that claims 13 and 14 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, independent claims 1, 23, and 33 have been amended to incorporate the allowable limitations of claim 14, thus making independent claims 1, 23, and 33 patentably distinguishable over the prior art. Accordingly, applicants' representative respectfully requests withdrawal of this rejection.

### **IV. Rejections of Claims 8, 12 and 15-18 Under 35 U.S.C. §103(a)**

Claims 8, 12 and 15-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over various combinations of references. The Examiner has indicated that claim 14 would be allowable if written in independent form with all of the limitations of the base claim and any intervening claims because the prior art does not teach or suggest the limitations in claim 14. Independent claims 1, 23, and 33 have been amended to incorporate the allowable limitations of claim 14 - claims 8, 12 and 15-18 respectively depend from independent claim 1, and therefore withdrawal of this rejection is respectfully requested.

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**V. Examination of Claim 34**

It is noted that the Examiner has not yet made a determination of the patentability of independent claim 34. It is therefore requested that any office action proceeding from this reply should not be deemed final. However, independent claim 34 has been amended from its original form to include the allowable limitations of claim 14.

**Conclusion**

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [AMDP986US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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